

Applicant: George B. Stefano et al.
Serial No.: 09/530,880
Filed: September 28, 2000
Page: 3

Attorney Docket No. 09598-004001/
Client Ref. No. R1224-432

REMARKS

The Examiner rejected claims 33-40. Claim 33 has been amended, and claims 41-47 have been added herein. Thus, claims 33-47 are pending. No new matter is added by these amendments. In light of these amendments and the following remarks, Applicants respectfully request reconsideration and allowance of claims 33-47.

Examiner Interview

Applicants' agent thanks Examiner Landsman for the courtesy of the telephonic interview on September 9, 2002. The substance of this interview involved the issues and amendments presented herein.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 33-40 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which is most nearly connected, to make and/or use the invention. Specifically, the Examiner stated that the "limitation in the claims that the ESR response in [is] only inhibited by tamoxifen does not enable the artisan to differentiate between an agonist acting at either an ESR or a nuclear estrogen receptor since the actions of both of these receptors are inhibited by tamoxifen." In addition, the Examiner stated that the claims do not limit the agonist to one which is not permeable to cell membranes, concluding that the claimed method is not enabled.

Applicants respectfully disagree. A person having ordinary skill in the art would have been capable of practicing the claimed invention without undue experimentation.

To further prosecution, however, claim 33 has been amended herein to recite that induction of the estrogen surface receptor-mediated response is not inhibited by ICI 182,780.

In light of the above, Applicants respectfully request withdrawal of the rejection of claims 33-40 under 35 U.S.C. § 112, first paragraph.

Applicant: George B. Stefano et al.
Serial No.: 09/530,880
Filed: September 28, 2000
Page: 4

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Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 33-40 under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps. Specifically, the Examiner stated that "claim 33 omits the essential step of either (1) screening for agonists which are known not to cross the cell membrane, or (2) that the activity of the potential estrogen receptor agonist is inhibited by tamoxifen, but not by ICI 182,780."

Applicants respectfully disagree. A person having ordinary skill in the art reading claim 33 would have understood that no essential steps have been omitted. To further prosecution, however, claim 33 has been amended herein to recite that induction of the estrogen surface receptor-mediated response is not inhibited by ICI 182,780.

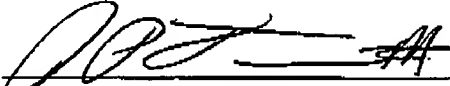
In light of the above, Applicants respectfully request withdrawal of the rejection of claims 33-40 under 35 U.S.C. § 112, second paragraph.

CONCLUSION

Applicants submit that claims 33-47 are in condition for allowance, which action is requested. Attached is a marked-up version of the changes being made by the current amendment. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: September 13, 2002



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Applicant: George B. Stefano et al.
Serial No.: 09/530,880
Filed: September 28, 2000
Page: 5

Attorney Docket No. 09598-004001/
Client Ref. No. R1224-432

Version with markings to show changes made

In the claims:

Claim 33 has been amended as follows:

33. (Amended Twice) A method for identifying an estrogen surface receptor agonist, said method comprising:

a) contacting a cell with a test molecule, wherein said cell expresses an estrogen surface receptor, and

b) determining if said test molecule induces an estrogen surface receptor-mediated response in said cell in an estrogen surface receptor-specific manner, wherein induction of said estrogen surface receptor-mediated response in said cell in said estrogen surface receptor-specific manner is inhibited by tamoxifen, is not inhibited by ICI 182,780, and indicates that said test molecule is said estrogen surface receptor agonist.

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